

REMARKS

Claims 1-41 are now pending in the application. The amendments to the claims contained herein are of equivalent scope as originally filed and, thus, are not a narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grainger (USPAP 20020161733) (Grainger1) in view of Grainger (USPAP 20020091542) (Grainger2). This rejection is respectfully traversed.

The present application addresses a problem with prior art online systems as set out at [0007] of the specification as published, that is, the variable cost per trade mark application inhibits the extension of online registered trade mark filing facilities and inhibits applicants from using websites to apply to register trade marks.

The cost of a trade mark application is made up of many different factors including hourly rate (which can be different for each lawyer), fixed scale charges, which can be different per client depending on an amount of discount given, and different per country official fees, which can be in a currency other than that which payment is received, thereby altering by the minute, as international exchange rates alter.

In addition to each type of charge varying, either on a lawyer by lawyer basis, or on an exchange rate basis, the cost of a trade mark application also varies because:

- different trade mark applications take a different amount of time (and therefore different costs even at the same hourly rate)

- different trade mark applications require different legal requirements, e.g. marks in colour incur additional fees to those in black and white, trade mark applications having a different number of classes incur different fees on a per class basis
- additionally, extra legal claims such as claim to priority, or a claim to seniority from other trade mark applications or registrations will incur extra fees in supplying extra documentation such as certified copies of documents, notarizations and legalizations
- official fees vary country to country
- subcontract attorney fees vary firm by firm and individual by individual

Prior art websites tend to restrict themselves either by:

- restricting the number of currencies in which payment is accepted
- restricting the number of territories in which rights can be obtained (thereby reducing foreign exchange rate risk, and differences in prices between different lawyers)
- avoiding calculation of cost data in real time, but rather relying on a pre-set price list

For many trade mark right owners, a basic problem which they have in using the intellectual property system, including lawyers, is that costs are not predictable and controllable in advance.

The embodiments of the present invention allow the giving of quotes or estimates in advance of performing an operation for filing or prosecution of an intellectual property right, which is accurate and up to date, and does not rely upon actually doing the operation first and then sending an invoice calculated as a result of the instructed operations.

The present disclosure, in order to be proactively competitive on cost on a before-the-event basis, relies upon having an up-to-date database (look up table) storing information selected from the set:

- official fees for trade marks in different countries;
- current fees for a vendor providing a service;
- a list of fees for different foreign associates providing a sub contracted legal service;
- a list of exchange rates between currencies

Grainger 1 (US 2002 0161733)

Grainger 1 was filed on November 27, 2001, that is, after the filing date of the present application. Grainger 1 was published on October 31, 2002, again after the filing date of the present application.

The material contained in Grainger 1 was not publicly available at the time of filing the present application.

The inventors were unaware of the Grainger 1 application at the time of making their invention.

The problem addressed in Grainger 1 is as set out at [0010], as being a problem of managing and tracking all the various due dates, communications and papers associated with the filing of intellectual property rights.

The objective of Grainger 1 is as set out at [0013] as being "...improve matters of facilitating the preparation of intellectual property documents, including patent applications, securing intellectual property rights and managing intellectual property assets, including pending patent applications and issued or granted patents...".

Consequently, Grainger 1 teaches a method of replacing paper based correspondence with electronic correspondence for the purpose of filing and prosecuting intellectual property rights in general.

There is no disclosure in Grainger 1 of providing an up-front quotation/estimate for a trade mark application procedure. The text of Grainger 1 pointed out by the examiner at sections [0008] and [0035] does not disclose displaying a collection of cost data before filing an application.

In contrast at [0008] of Grainger 1 this discloses the usual method of doing the work first and paying the official fees, and then sending an invoice afterwards, to whatever the accumulated and already incurred costs are calculated to work out as, after the event.

Grainger 1 does not explicitly teach calculating substantially in real time cost data relating to a cost of a registered trade mark application from stored data.

Grainger 2 (US 2002/0091542)

Grainger 2 was filed on November 27, 2001 and published on July 11, 2002.

Since the filing date of the present application is July 19, 2001, Grainger 2 was not publicly available at the time of filing the present application. Further, the inventors were unaware of Grainger 2 at the time of the invention, and at the time of filing the present US patent application.

The problem addressed in Grainger 2 (US 2002/0091542) is as disclosed at [0007] of that published document. The typical problem is that when paying a maintenance or annuity fee on a particular intellectual property right, the physical

documents are not available to the person making the decision, thereby making the decision difficult or time consuming since the physical documents need to be obtained.

The problem addressed in Grainger 2 is as disclosed at [007] to [0013] as:

"Prosecution of a patent application involves over a hundred separate transactions between applicant, inventor, patent agents and Patent Offices. There is difficulty in managing this number of communications.

Outside annuity payment services do not interface with law firms or technology developers, and maintain their own separate databases for docketed annuity dates.

Tracking all the various due dates, communications and papers associated with patent filings is a large burden.

The ability of a technology developer manager to know and understand the contents of the technology developers intellectual property portfolio decreases as the size of the portfolio increases. Databases and other tools limit a technology developers managers ability to know the contents and status of the patent assets in their patent portfolio.

It is difficult to increase the number of patent applications prepared using current manual systems."

The object of the invention is set out in [0013] of Grainger 2 as "improved methods of facilitating the preparation of intellectual property documents including patent applications, securing intellectual property rights and managing intellectual property assets including pending patent applications and issued or granted patents are desirable".

The solutions set out in Grainger 2 is set out in [0015] and [0016] to focus on storing a set of work flow rules on a server system which takes an inventor through the process of typing in a description of the invention into a centralised server, or cut and pasting such a description, and then managing documents to send them to patent lawyers and the Patent Office.

The solution in Grainger 2 is to provide a summary of invention, or a patent claim as information accessible via a communication to the user, which is generated in response to a stored due date, which acts as a trigger for sending information to a user. Thus, the user has the information on the precise nature of the rights available at the time of making a decision on payment of a fee.

In Grainger 2, the primary motivating feature is to make all documents concerning a patent application electronic at the earliest stage, and then to deal between lawyers, patent offices and applicant/inventor electronically thereafter. The problem, objectives and solutions set out in Grainger 2 are completely different from the problem, objective and solution of the present application.

Whilst Grainger does include a cost estimator as shown in figure 5 of that document, and as described at [0047], does not disclose explicitly, how the costs are calculated. Thus, figure 5 of Grainger 2 could be considered more as a cost display of pre-calculated information, rather than as a display of real time calculated cost data.

Grainger 2 does disclose in figure 4G and [0131] to [0133] a display for the payment of maintenance fees, which have a cost associated with them. However, there is no disclosure of how these costs are generated. At [0139] Grainger 2 includes an accounting system to track payments made on behalf of a customer and to generate "appropriate bills" to such customers in the future. There is also at [0140] software for invoicing of and payment of practitioner fees.

All of these fees are "after the event fees" where the cost is not fixed in advance, with the exception of the annuity payments. For all operations except annuities, it appears in Grainger 2 that the cost is not agreed or known in advance. Rather, the

opposite is true. At [00140] second sentence onwards, it is clear that the fees and costs are on a "pay as you go" basis depending upon time spent by patent practitioners rather than on a fixed cost in advance.

Grainger 2 does not create a set of fixed costs known in advance before the IP right has been applied for, and therefore does nothing to address the problem of variable costs per trade mark application as set out in [0007] of the present application in the suit.

Accordingly, in order to more fully distinguish applicants' invention from the cited art, the independent claims have been amended to make it more clear that the calculated cost represents a real time running total cost of a current transaction instruction for said registered trade mark application, *said cost changing on entering or subtracting information and instructions relating to said registered trade mark application*. Reconsideration and allowance of applicants' claims is therefore respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner

believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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